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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/635,598 | 08/06/2003 | David Louis Kaminsky | RSW920030090US1 (103) | 1386 |
| 46320 | 7590 | 02/08/2007 | EXAMINER | |
| CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP | | | TANG, KAREN C | |
| STEVEN M. GREENBERG | | | ART UNIT | PAPER NUMBER |
| 950 PENINSULA CORPORATE CIRCLE | | | | |
| SUITE 3020 | | | 2151 | |
| BOCA RATON, FL 33487 | | | | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 02/08/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/635,598 | KAMINSKY ET AL. | |
| | Examiner | Art Unit | |
| | Karen C. Tang | 2151 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 August 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-24 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f),
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8/6/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-24 are presented for examination.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Intelligent mail gateway".

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

Claims 1-4 are recites the limitation "said manager" in Claim 1, Lines 6. There is insufficient antecedent basis for this limitation in the claim.

Claims 5-14, are recites the limitation "said messages" in Claim 1, Lines 6. There is insufficient antecedent basis for this limitation in the claim.

Claims 15-24 have similar problem as Claims 5-14, correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 6, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by

Spear (US 2003/0149726).

2. Referring to Claims 1, 4, 5, and 15, Spear disclosed storing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers (refer to 0026, gateway comprising the mail queue); detecting an impairment to delivering said messages to said inboxes (refer to 0029, amount of damage a particular damage or unwanted messages in the queue, refer to 0029); identifying senders for selected one of said messages (refer to 0030, Lines 11-12); and forwarding a notification of said impairment to said identified senders (refer to 0030, Lines 11-12, sent back the original messages as a type of notification of said impairment).

3. Referring to Claims 6 and 16, Spear disclosed wherein said storing step comprises the step of queuing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers (refer to 0026).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 8, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Shuster (US 2002/0023135).

4. Referring to Claims 7, 8, 17, and 18, Spear disclosed wherein said detecting step comprises the step of consulting a data store of state information that already have identified impairment (refer to 0033).

Although Spear disclosed the invention substantially as claimed, Spear is silence regarding consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment.

Shuster, in an analogous art disclosed consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment (refer to 0039, Lines 17-22).

Hence, providing consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment disclosed by Shuster, would be desired for users to utilize due to the fact it can save loading time and efficiently eliminate junk mail from the mail system (refer to 0009).

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Shuster that efficiently improve the overall functionality of the system.

Claims 9, and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Eguchi (US 2001/0040694).

5. Referring to Claims 9 and 19, although Spear disclosed the invention substantially as claimed, Spear is silence regarding: wherein said detecting step comprises the steps of: attempting to transmit said messages; and, concluding the existence of an impaired state when said attempt fails.

Eguchi in an analogous art disclosed attempting to transmit said messages (refer to 0014); and, concluding the existence of an impaired state when said attempt fails (refer to 0014).

Hence, providing steps of detecting by concluding the existence of an impaired state by attempting to transmit said messages disclosed by Eguchi, would be desired for users to utilize due to the fact that (refer to 0009) it save time providing a kind of receipt from the recipients knowing that whether or not they can receive proper messages.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Eguchi that efficiently improve the overall functionality of the system.

Claims 3, 10, 11, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Pearson et al hereinafter Pearson (US 2005/0235360).

6. Referring to Claims 3, 10, 11, 20 and 21, although Spear disclosed the invention substantially as claimed, Spear is silence regarding: wherein said step of identifying comprising the step of identifying only priority senders (refer to 0020).

Pearson, in an analogous art disclosed, wherein said step of identifying comprising the step of identifying only priority senders (refer to 0011).

Hence, providing step of identifying only priority sender disclosed by Pearson, would be desired for users to utilize due to the fact it eliminate non priority senders and saving processing time (refer to 0009).

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Pearson that efficiently improve the overall functionality of the system.

Claims 12, 13, 14, 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Generous et al hereinafter Generous (US 20020120697).

7. Referring to Claims 12, 13, 14, 22, 23, and 24: although Spear disclosed the invention substantially as claimed, Spear is silence regarding:

wherein for each of said identified senders, formatting a notification comprising both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages; and, forwarding said detailed notification to said identified senders.

Generous, in an analogous art disclosed, wherein for each of said identified senders, formatting a notification comprising both a statement of said impairment and an alternate e-mail address (refer to 0372) for use in retransmitting a corresponding one of said messages (refer to 0341-0349); and, forwarding said detailed notification to said identified senders (0341-0349).

Hence, providing step of formatting a notification comprising both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages; and, forwarding said detailed notification to said identified senders disclosed by Generous, would be desired for users to utilize due to the fact it provides the fastest time and proper knowledge of how to retransmit the messages to the proper destination.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Generous that efficiently improve the overall functionality of the system.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Katagiri et al hereinafter Katagiri (US 20020073364) in further view of Generous et al hereinafter Generous (US 20020120697).

8. Referring to Claim 2, although Spear disclosed the invention substantially as claimed, Spear is silence regarding: disclosed message generation logic programmed to format

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notifications for said senders which indicates at least one of an estimated down time of said mail server; an estimated time when said delivery will no longer be impaired; and an alternate e-mail address with which said selected one of said senders can retransmit said messages to corresponding intended recipients.

Katagiri, in an analogous art disclosed message generation logic programmed to format notifications for said senders which indicates at least one of an estimated down time of said mail server (refer to 0076); an estimated time when said delivery will no longer be impaired (refer to 0065);

Hence, providing step of disclosed message generation logic programmed to format notifications for said senders which indicates at least one of an estimated down time of said mail server; an estimated time when said delivery will no longer be impaired disclosed by Katagiri, would be desired for users to utilize due to the fact that providing senders the additional information indicating the problem of the system in order to save time and allow users to think of alternative ways to perform further communication.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Katagiri that efficiently improve the overall functionality of the system.

although Spear and Katagiri disclosed the invention substantially as claimed, both is silence regarding: an alternate e-mail address with which said selected one of said senders can retransmit said messages to corresponding intended recipients.

Generous, in an analogous art disclosed an alternate e-mail address with which said selected one of said senders can retransmit said messages to corresponding intended recipients (refer to 0372).

Hence, providing step of formatting a notification comprising both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages; and, forwarding said detailed notification to said identified senders disclosed by Generous, would be desired for users to utilize due to the fact it provides the fastest time and proper knowledge of how to retransmit the messages to the proper destination.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Generous that efficiently improve the overall functionality of the system.

Conclusion

9. **Examiner's Notes:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

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10. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karen Tang



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